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In re Application of
ARNOLD-HUYSER *et al*
U.S. Application No.: 10/532,025
PCT No.: PCT/US2003/033242
Int. Filing Date: 20 October 2003
Priority Date: 21 October 2002
Attorney Docket No.: 026032-4899
For: POINT-OF-INTEREST DISPLAY
SYSTEM

DECISION

This decision is in response to applicants' "Petition Under 37 C.F.R. 1.47" filed 23 February 2006.

BACKGROUND

On 23 September 2005, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) was required. Applicants were given two months to respond with extensions of time available.

On 23 February 2006, applicants filed the instant petition which was accompanied by, *inter alia*, the petition fee; a three-month extension and fee; a declaration; a copy of a receipt for certified mail; and a copy of an email dated 18 December 2005.

DISCUSSION

A petition under 37 CFR 1.47(a) requires: (1) the petition fee; (2) factual proof that the missing joint inventor cannot be located or refuses to cooperate; (3) a statement of the last known address of the nonsigning joint inventor; (4) and an oath or declaration executed by the signing joint inventor on their behalf and on behalf of the nonsigning joint inventor.

Concerning item (1), the \$200.00 petition fee has been paid.

With regards to item (3), the last known address of John S. Bambini is listed as:

5490 Brattleboro Dr. SE

Kentwood, MI 49508-6302

Concerning item (4), the 37 CFR 1.47(a) applicant submitted a declaration signed by four of the five named inventors on their own behalf and on behalf of the nonsigning joint inventor. This declaration meets the requirements of section 409.03(a) and is in compliance with 37 CFR 1.497(a) and (b).

Items (1), (3) and (4) of 37 CFR 1.47(a) are satisfied.

Regarding item (2), the 37 CFR 1.47(a) applicant claims that the nonsigning inventor was contacted by email, telephone and by certified letter. Mr. Bambini responded with an email message on 18 December 2005 stating his refusal to sign the papers. A copy of this email was included with the subject petition along with a copy of a receipt of certified mail. A copy of the certified letter was not provided. This is treated as a refusal to cooperate.

Section 409.03(d) of the MPEP discusses a refusal by an inventor to cooperate and states, in part:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney . . . It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

Here, petitioners failed to provide evidence showing that a complete copy of the subject application was sent and received by the nonsigning inventor. The email message does not show that a copy of the subject application was received by Mr. Bambini. Petitioners have not provided any other documentary evidence showing that a copy of the application was presented to Mr. Bambini.

As such, item (2) is not yet satisfied.

CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. No additional petition fee is required.

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.


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